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10 MAR 1999

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In re Application of
SHAPIRO

Serial No.: 09/194619

PCT No.: PCT/US96/13850

Int. Filing Date: 29 August 1996

Priority Date: 01 September 1995

Attorney Docket No.: P-1018

For: METHODS AND COMPOSITIONS FOR
DEVELOPMENT OF DRUG
SCREENING PROCEDURES AND
DIAGNOSTIC TOOLS

DECISION ON
PETITION FOR REVIVAL
UNDER 37 CFR 1.137(b)

This decision is in response to applicant's "PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)" filed 24 November 1998 in the above-captioned application.

BACKGROUND

On 29 August 1996, applicant filed international application No. PCT/US96/13850 which claimed a priority date of 01 September 1995, and which designated the United States.

No Demand was filed with the International Preliminary Examining Authority electing the United States. As a result, the deadline for payment of the basic national fee was to expire 20 months from the priority date, at midnight on 01 May 1997. Thereafter, the application was abandoned by operation of 35 U.S.C. 371 and 37 CFR 1.494(b)(2).

A transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 has not been filed. Applicant states that a small entity status statement was previously filed but no such statement is found in the file. There is no reference to its filing in a previous application.

On 24 November 1998, the present petition seeking revival under 37 CFR 1.137(b) was filed with the small entity petition filing fee of \$660.00 and ISA-U.S. fees for small entity in the amount of \$395.00 plus US national filing fee of \$49.00. No authorization to charge applicant's deposit account was given. Although the petition was received and assigned file number 09/194619, applicant has not expressly requested that the national examination procedures begin under 35 U.S.C. 371.

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after applicant becomes aware of the abandonment and must be accompanied by: (1) the required reply, unless previously filed, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional and (4) a terminal disclaimer (for applications filed before 8 June 1995). Further, 37 CFR 1.137(b)(3) provides that the PTO may require additional information where there is a question whether the delay was intentional. *See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63 (October 21, 1997) (Effective Date: 01 December 1997).*

Applicant has not satisfied items (1), (2), and (3). As to item (4), since the application was filed after 08 June 1996, a terminal disclaimer is not required.

With regard to Item (2), the petition fee paid is insufficient. Applicant paid \$660.00 for the small entity petition fee without filing a small entity status statement. The correct petition fee for small entity is \$605.00. Since no small entity status statement is filed, the required fee for applicant's petition is \$1,210.00 under 37 CFR 1.17(m).

As to Item (1), Applicant has not filed the proper reply with his petition. The proper reply includes an expressed request to enter the national stage under 35 U.S.C. 371 and the appropriate national stage fees. Applicant has not clearly expressed his intention to enter the national stage under 35 U.S.C. 371. As for the appropriate fees, although applicant submitted \$49.00 as US national filing fee and \$395.00 for basic fee (small entity), this is not the correct national stage fees of \$760.00. Should applicant wish to submit the national stage fees for small entity (\$380.00), the small entity status statement must be filed.

Item (3) is not satisfied by Applicant's statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional". The petition in this case was filed over a year after the application was abandoned.

Where a petition under 37 CFR 1.137(a) or (b) is not filed within one year of the date of the abandonment of the application, the PTO may consider there to be a question as to whether the delay was unavoidable or even unintentional. In cases where a petition under 37 CFR 1.137(a) or (b) is not filed within one year of the date of abandonment, the Office may require: (1) further information as to when the applicant first became aware of the abandonment and (2) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care and diligence on the part of the applicant or applicant's representative (*see Ex Parte Pratt*, 1887 Dec. Comm'r Pat. 31 (1887)). Further, in cases where a petition under 37 CFR 1.137 is not filed within three months of the date the applicant first became aware of the abandonment, the Office may require further information as to the cause of the delay between the date the applicant first became aware of the abandonment and the date on which a petition under 37 CFR 1.137 was filed. *See 62 Fed. Reg. at 53159; 1203 Off. Gaz. Pat. Office at 87.*

In this case, the application became abandoned at midnight on 01 May 1997 for failure to pay the basic national fee within 20 months of the priority date. The first petition under 37 CFR 1.137 to revive the application was not filed until 24 November 1998, over one year after the date of abandonment. This substantial delay raises a question as to whether the delay was intentional. Accordingly, it is appropriate for the Office to require further information as to how the delay in discovering the abandoned status occurred despite the exercise of due care and diligence on the part of applicant and/or applicant's representatives. Further explanation is required regarding when applicant understood the Demand was not filed, when applicant learned the application was abandoned, why the length of delay in filing between the twenty month deadline and the thirty month deadline. *See MPEP 711.03(c)*. A copy of *MPEP 711.03(c)* is enclosed for applicant's convenience.

Therefore, since petitioner has not satisfactorily explained how the delay in discovering the abandoned status of the application occurred despite the exercise of due care and diligence on the part of applicant and/or his chosen representative, the PTO cannot conclude that the entire delay in filing the basic national fee from the due date of the fee on 01 May 1997 until the date of filing a grantable petition was unintentional. Accordingly, the granting of the petition under 37 CFR 1.137(b) for revival based on unintentional delay would not be proper at this time.

Thus, all the requirements of 37 CFR 1.137(b) have not been fulfilled and the application remains **ABANDONED**.

CONCLUSION

The petition under 37 CFR §1.137(b) to revive the above-captioned application is

DISMISSED WITHOUT PREJUDICE.


Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. The request for reconsideration should include a cover letter entitled "Renewed Petition under 37 CFR §1.137(b)".

Extensions of time under 37 CFR §1.136(a) are permitted.

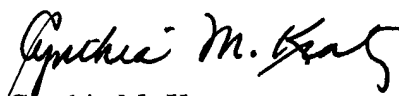
Any renewed petition filed must include a proper reply. A proper reply must include the requisite 35 U.S.C. 371(c) filings, appropriate petition fee and a detailed explanation for the entire period of delay from the date of abandonment through the date of filing a grantable petition as discussed above.

As an aid to applicant, enclosed are copies of the Transmittal Letter to the United States Designated/Elected Office Concerning A Filing Under 35 U.S.C. 371 (Form PTO-1390), Declaration for Utility or Design Patent Application (Form PTO/SB/01) and Statement Claiming Small Entity Status (Form PTO/SB/09 and 10).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.


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Enclosures: Transmittal Letter to the United States Designated/Elected Office Concerning A Filing Under 35 U.S.C. 371 (Form PTO-1390), Declaration for Utility or Design Patent Application (Form PTO/SB/01), Statement Claiming Small Entity Status (Form PTO/SB/09 and 10), *MPEP 711.03(c)*.